

"polymer" after the phrase "and a ratio of powdery". The omission of the term "polymer" in claims 1 and 5-8 is a typographical error. The term is supported in the specification at page 33, lines 1-4.

No new matter within the meaning of § 132 has been added by any of the amendments.

The specification has also been amended at page 1 to reference the parent application.

Applicants requested an Applicant-initiated Interview on March 2, 2004. Although the outstanding Office Action is a first action, it is noted that the captioned application is on remand from an Appeal to the Board of Patent Appeals and Interferences made in Paper No. 18 of the parent application 08/651,492. Furthermore, a first Request for Continued Examination ("RCE") was filed in the captioned application on March 4, 2003, and a second RCE was again filed on January 7, 2004.

It is noted that in both instances that claim amendment were made pursuant to discussions with the Examiner. For example, pursuant to a telephonic Interview with the Examiner on January 7, 2003, Applicants filed an amendment on March 4, 2003, directed to additional claim limitations regarding the catalytic activity under particular polymerization conditions.

However, in the Final Office Action of October 7, 2003, the Examiner stated that the working examples only provide support for

individual catalyst activity points and not the whole range. See Final Office Action at page 2, paragraph 1.

Applicants then filed an RCE on January 7, 2004, directed to the specific points with the claim language "at or around". But again, in an Office Action dated February 13, 2004, the Examiner rejected the claim because the disclosure is not alleged to support the catalyst activity "at or around" the data points.

Therefore, in order to develop and clarify specific issues and lead to a mutual understanding between the Examiner and Applicants and thereby advance the prosecution of the application, Applicants requested an Interview with the Examiner on March 2, 2004. However, the Examiner refused the Interview.

Worrisome to Applicants is the Examiner's statement during the telephonic discussion of March 2, 2004, that a proposed amendment to remove the phrase "at or around" to recite activity at specific date points would result in a patent of little value. Given that the Examiner is not in a position to determine the putative value derived from the patent claims, Applicants request the Examiner to refrain from speculating on the "value" of a patent and to instead confine herself to substantive examination on the merits.

Accordingly, Applicants respectfully request the Examiner to enter the claim amendment, reconsider and withdraw the rejections and allow all claims pending in this application.

1. Rejection of Claims 1-9
under 35 U.S.C. § 112, ¶ 1

The Office Action rejects claims 1-9 under 35 U.S.C. § 112, ¶ 1 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office Action states:

The newly added catalyst activity limitations of "at or around 44,800 g-polymer/g-catalyst" in Claim 1, "at or around 52,900 g-polymer/g-catalyst" in Claim 2, "at or around 49,500 g-polymer/g-catalyst" in Claim 5, "at or around 49,700 g-polymer/g-catalyst" in Claim 6, "at or around 50,100 g-polymer/g-catalyst" in Claim 7, "at or around 52,800 g-polymer/g-catalyst" in Claim 8, and "at or around 54,600 g-polymer/g-catalyst" in Claim 9 are new matter. Applicants' disclosure in Tables 3 and 4 of the Specification only support those catalyst activities at those specified points with specified catalyst compositions of the working examples, the disclosure does not support catalyst activities at or around those specified points and with the catalyst components in the specified ranges of the instant claims.

Applicants are advised to file a continuation in part application (if it is possible) to disclose the activities of the catalysts of the instant claims in range in order to overcome the new matter rejections supra.

Applicants traverse the rejection because the rejection fails

to provide express findings of fact which support the lack of a written description. In particular, the Office Action fails to provide any reason why a person skilled in the art at the time the application was filed would not have recognized that the disclosure does not support the limitation of "at or around" for the specifically claimed data points.

As stated in MPEP § 2163.04, the inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. See, e.g., In re Marzocchi, 169 USPQ 367, 370 (CCPA 1971).

The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner also has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in Applicant's disclosure a description of the invention defined by the claims. Wertheim, 191 USPQ at 97. The general allegation of "unpredictability in the art" is not a sufficient reason to support a rejection for lack of adequate written description.

In the present application, the outstanding Office Action fails to provide why a person skilled in the art would not

recognize that support is provided for catalyst activity points at or around the claimed data points given that the disclosure provides activities across numerous data points all within the general range between 44,800 and 52,800 g-PE/g-catalyst. See Table 3 at page 41. One of ordinary skill in the art would clearly know that Applicants had possession of catalytic activities at or around the claimed data points given the actual reduction to practice of data points in relative close proximity.

As noted by the Federal Circuit, relative terms such as "about" can be used to define the general area of a particular data point. See Ex parte Eastwood, 163 USPQ 316 (Bd. App. 1968) (holding that the area of the lower end of a mold as between 25 to about 45% of the mold entrance was held to be clear, but flexible); W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983) (holding that a limitation defining the stretch rate of a plastic as "exceeding about 10% per second" is definite because infringement could clearly be assessed through the use of a stopwatch).

However, in the interest of advancing prosecution, Applicants have deleted the phrase "at or around" from the claims. Since only specific data points are claimed, Applicants submit that the claims as pending satisfy the written description requirement as narrowly interpreted by the Examiner.

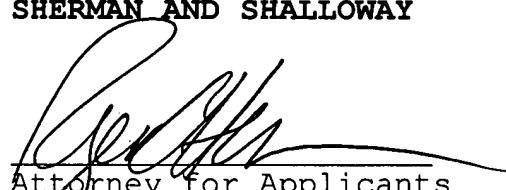
Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 112, ¶ 1 rejection of claims 1-9.

CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. The Examiner is therefore respectfully requested to reconsider and withdraw the rejection of the pending claims and allow the pending claims. Favorable action with an early allowance of the claims pending is earnestly solicited.

Respectfully submitted,

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